REMARKS

This Amendment is submitted simultaneously with filing of a Request for Continuing Examination.

In the last Office Action Claims 1-9, 11, 13-19, 21, 23, 25-28, 33 and 35 were rejected under 35 USC 102(b) over the U.S. patent to Modrey.

Claim 10 was rejected under 35 USC 103(a) over the U.S. patent to Modrey and admitted prior art.

Claims 24 and 29-31 have been rejected under 35 USC 103(a) over the U.S. patent to Modrey in view of the paten to Strozel.

Claims 32 and 34 are rejected under 35 USC 103(a) over the patent to Modrey.

After carefully considering the Examiner's grounds for rejection of the claims over the art, applicants amended Claim 1, the broadest claim on file, so as to more clearly define the present invention and to distinguish it from the prior art.

The new features of Claim 1 as amended are disclosed in the original Claims 8, 21, 24, 27 and 29.

Turning now to the Examiner's rejection of the claims over the art, it is respectfully submitted that the patent to Modrey (US 2,776,385) discloses an electric power unit including an electric motor which is enclosed in a housing (13). For ventilating all parts of the motor, a ventilation channel consisting of two parts (14, 15) is arranged in the housing (13). To connect the two parts (14, 15) with the exterior of the electric power unit an inlet duct (19) and an exhaust duct (20) are provided in a hose (16), wherein the latter is connected to the housing (13) through a connector (30, 31) with cones (40, 41) (as disclosed in the patent to Modrey, figure 9 and column 2, line 55 to column 3, line 36). A junction between the housing (13) and the hose (16) is arranged diagonally in respect to a longitudinal direction of the housing (13) as can be seen in figure 1 of Modrey. One part (14) of the ventilation channel represents the corresponding means to the inlet duct (19) and the other part (15) corresponds to the exhaust duct (20). The parts (14, 15) of the ventilation channel merge with each other after a passage of the motor. Therefore, the parts (14, 15) represent input and output means or ducts of only one ventilation channel, which is integrally formed in the same housing (13) as the motor (as disclosed in the patent to Modrey, figure 1 and column 2, lines 55 to 59).

The patent to Modrey does not have the feature that an intake nozzle extends (32, as mentioned by the Examiner) in a longitudinal direction of the housing (13). The intake nozzle (32) of Modrey extends in a diagonal direction of the housing (13) and is integrally formed into the outer wall of the housing (13) which can be seen in figure 1 of the patent to Modrey. Furthermore, the patent to Modrey does not disclose that the ventilation channel is separated from the housing (13) by means of an additional casing which is located in an interior of the housing (13) and that the ventilation channel is formed in an interior of said additional casing. The ventilation channel of the patent to Modrey is integrally formed with the housing (13) whereby the ventilation channel is formed as a fixedly connected part of the housing (13). The ventilation channel uses free space in the housing (13) to cool down the electric motor.

Moreover, the patent to Modrey does not have the feature that at least two ventilation channels are provided which in their entirely extend in a direction which is parallel to the longitudinal direction of the housing (13) and which in their entirety are arranged parallel relative to each other. Furthermore, the patent to Modrey lacks the features that at least two intake nozzles (32) are provided which extend in the ventilation channels and that the intake nozzles (32) and the ventilation channels are provided to lead cooling air unhindered from the intake nozzles (32) to the motor housing (13). Therefore, the present patent

application as recited in the amended claim 1 should be novel over the patent to Modrey.

The Examiner rejected the claims over the patent to Modrey as being anticipated. In connection with this, it is believed to be advisable to cite the decision In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

> "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Modrey does not disclose each and every element of the electric power tool of the present invention as defined in amended claim 1. Therefore, the anticipation rejection of the original claims should be considered as not tenable with respect to amended claim 1 and should be withdrawn.

The present invention also cannot be considered as obvious from the reference. An advantage of the invention disclosed in the present patent application is that the cooling conduits (30) can easily be integrated in all kind of power tools through the separation of the cooling conduits (30) from the housing (10) by means of an additional casing (38). In the industry of today the modular concept is widely spread and through such a construction as disclosed in the

present patent application, a broad field of use is available. Therefore, time and money can be saved in the development by this construction.

Another advantage of the invention disclosed in the present patent application is the arrangement of two intake nozzles (20) and two cooling conduits (30) in the housing (10) whereby a good distribution of coolant supply can advantageously be reached. Furthermore, the little turbulence of the two rectilinearly arranged intake nozzles (20) and the cooling conduits (30) makes it possible that a small diameter of the intake nozzles (20) and a small diameter of the cooling conduits (30) can be chosen to cool down the motor. Therefore, mounting space can advantageously be saved.

Furthermore, a cooling air flow with little turbulence can advantageously be created because the cooling air can reach the electric motor unhindered by means of the arrangement of the intake nozzles (20) and the cooling conduits (30) according to the patent application. Therefore, a deposition of entrained dirt inside the housing (10) can be avoided. Furthermore, a high speed of the cooling air flow can be maintained for a good cooling of the electric motor (see patent application, page 3, lines 24 to 31).

In contrast to the invention disclosed in the present patent application the patent to Modrey discloses a ventilation channel which is

integrally formed within the housing (13) of an electric power unit. The ventilation channel is connected via an intake nozzle (32) with an inlet duct (19) and an outlet duct (20) whereby both ducts (19, 20) are arranged in a separate hose (16). The hose (16) is coupled to the housing (13) via an engaging member (31). The ventilation channel approximately extends from the inlet duct (19) near the intake nozzle (32) perpendicular to an armature shaft of an electric motor and then the ventilation channel curls through the housing (13) until the ventilation channel again reaches the intake nozzle (32) at the outlet duct (20). Thereby, a lot of turbulences in a cooling air flow can be generated. The turbulences have a negative effect on the cooling of the electric motor. Furthermore, dust or other pollutions can be deposited in the housing (13) because of the curling course of the ventilation channel so that the ventilation channel can be blocked and the electric motor can be overheated.

It is respectfully submitted that a person skilled in the art could not find any hints, suggestion or motivation in the patent to Modrey at the time the invention was made which would have led him to the present patent application as recited in claim 1. If a person skilled in the art took the teaching of the patent to Modrey into consideration he would be led to construct one ventilation channel within a housing (13) of an electric power unit to cool down an electric motor. The person skilled in the art would construct the ventilation channel in such a

manner that the ventilation channel would have a curling course in the housing (13).

In addition, no encouragement is given to integrate an additional casing which separates the ventilation channel from the housing (13). The realization of an advantageous flexible assembly, which is molded beforehand and which consists of cooling conduits and an additional casing, and which further can be used in various power tools, is not necessary for the device disclosed in the Modrey patent, because the electric power unit is intended to be used in a flexible way with various power tools of its own volition (see Modrey, column 1, lines 20 to 26). A reconstruction of the electric power unit is not necessary for its advantageous use and an integration of a feature which does not improve the usability of a device is a waste of time, costs and components and would be contradictory towards the guidelines of mechanical engineering.

It is believed to be clear that a person skilled in the art could not find any hints which would have led him to the arrangement of two parallel ventilation channels in a longitudinal direction of the housing (13) and to a separation of the ventilation channel from the housing (13) by means of an additional casing. Therefore, the invention disclosed in the present patent application as recited in the new claim 1 can be considered as unobvious from the Modrey reference.

The U.S. patent to Strozel et al shows a driven guided machine, namely, an angle grinder (10), which has ventilation slots (30) on the front side of a housing (12). An inflowing, cooling air flow (32) moves through the ventilation slots (30) into the interior of the angle grinder (10) and flows there into ventilation channels (34) of the stator (27). The ventilation slots (30) do not extend in the ventilation channels (34) and the ventilation slots (30) and the ventilation channels (34) are not provided to lead cooling air unhindered from the ventilation slots (30) to a motor housing (12) in which an electric motor (14) is located (see Strozel et al, figure as well as column 2, lines 66 through column 3, line 6). In the patent to Strozel et al the cooling air will be deflected by some parts which are arranged in the inside of the housing (12). Turbulences will be produced and dust can be deposited in the housing (12) and the ventilation channels (32) whereby a cooling of the electric motor (14) can negatively be affected. Furthermore, the patent to Strozel et al discloses no hints to arrange the ventilation slots (30) in such a way that the ventilation slots (30) protrude over an outer wall of the housing (12). The patent to Strozel et al also does not disclose an additional casing for an arrangement of the ventilation channels (32) and the ventilation slots (30). In our opinion, a person skilled in the art could not find any hints which would have led him to the present patent application as recited in the new claim 1. Therefore, the invention disclosed in the present patent application as recited in the new claim 1 should be unobvious from Strozel et al.

Even if a person skilled in the art took a combination of the teaching of the patent to Modrey and the teaching of the patent to Strozel et al into consideration he would not be led to the present patent application as recited in claim 1. Therefore, the present patent application as recited in claim 1 should also be unobvious from the combination of the above patents.

It is believed to be clear that the references did not contain any hint, suggestion, or motivation for the new features of the present invention as defined in amended claim 1. In order to arrive at the present invention from the references it is not sufficient to use the teachings of the references taken singly or in combination with one another, but instead the references have to be fundamentally modified and in particular by including into them the new features of the present invention that were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision In Re Randol and Redford (165 USPQ 586) that:

> Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

The prior art references do not have any suggestions for such modifications.

Therefore, it is believed that Claim 1 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on Claim 1, they share its allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should

the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,
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